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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,787	06/13/2006	Masato Kaneda	Q79148	5976
23373 7590 11/03/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER BOFF, ANCA	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 11/03/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/582,787

**Applicant(s)**

KANEDA ET AL.

**Examiner**

ANCA EOOF

**Art Unit**

1795

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3.6 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3.6 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 3, 6 and 11-14 are pending. Claims 1-2, 4-5 and 7-10 are canceled.
2. The foreign priority document JP 2003-418112, filed in Japan on December 16, 2003 was received and acknowledged. However, in order to benefit of the earlier filing date, a certified English translation is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyatt et al. (US Pg-Pub 2003/0118946).

With regard to claims 3 and 14, Wyatt et al. disclose printing plate developing solvents comprising diisopropylbenzene, alone or in combination with one or more co-solvents (abstract).

Diisopropylbenzene has 12 carbon atoms in the molecule so it is equivalent to the aromatic hydrocarbon having 9 carbon atoms or more within the molecule of the instant application.

Wyatt et al. further disclose that other co-solvents may be mixed with diisopropylbenzene to enhance performance, alter physical properties, reduce cost of

form an azeotrope (par.0043) and such co-solvents may be alcohols or glycol ethers (par.0043).

Wyatt et al. disclose mixtures of solvents wherein diisopropylbenzene is present in an amount of 20% by weight (see Example 4 in Table 1, par.0062).

While Wyatt et al. do not disclose a mixture comprising 20% by weight of diisopropylbenzene and 80% by weight of one or more co-solvents, such as alcohols or glycol ethers, it would have been obvious to one of ordinary skill in the art at the time of the invention to use such mixture, based on Wyatt's teaching that one or more co-solvents, such as alcohols and glycol ethers may be added to diisopropylbenzene (par.0043) and that a developer may comprise 20% by weight of diisopropylbenzene and 80% by weight of co-solvents (see Example 4 in Table 1, par.0062).

The photopolymer printing plate developing solvents of Wyatt et al. render obvious the photosensitive composition remover of the instant application. The fact that the remover is used for removal of an uncured photosensitive composition is an intended use and adds no patentable weight to the claim.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"). (MPEP 2111.02- Effect of Preamble)

When the other co-solvents are alcohols or glycol ethers (par.0043), the limitations of claim 14 are met.

Claims 11-12 comprise limitations regarding the intended use of the photosensitive composition remover and such limitations do not add any patentable weight to the claim. Therefore, it is the examiner's position that the developing solvent of Wyatt et al. renders obvious to photosensitive composition remover of claims 11-12 of the instant application.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wyatt et al. (US Pg-Pub 2003/0118946) in view of Dhillon (US Patent 4,822,723).

With regard to claim 6, Wyatt et al. teach a printing plate developing solvent which comprises diisopropylbenzene and one or more co-solvents, such as alcohols or glycol ethers as applied to claim 1 (see paragraph 4 of the Office Action).

Wyatt et al. disclose that one of the co-solvents may be a glycol ether, such as dipropylene glycol methyl ether (par.0043) but fail to disclose propylene glycol monomethyl ether.

Dhillon teaches a developer composition for heavy duty printing plates (abstract), wherein said developer composition may comprise propylene glycol monomethyl ether or dipropylene glycol monomethyl ether (abstract and column 4, line 65-column 5, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use propylene glycol monomethyl ether as co-solvent for diisopropylbenzene in the developing solvent of Wyatt et al., propylene glycol

monomethyl ether being functionally equivalent to dipropylene glycol methyl ether in a developer composition, as taught by Dhillon.

Dhillon further discloses that in the developer composition, propylene glycol monomethyl ether should preferably be comprised in an amount of 45 to 55 % by weight (column 4, line 65 - column 5, line 3).

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyanagi et al. (WO 03/072634, wherein the citations are from the English equivalent document US Pg-Pub 2005/0153530) in view of Bantu et al. (US Patent 5,268,260).

Koyanagi et al. disclose that a developer for a photosensitive composition may be a solvent, such as cyclohexanone, tetramethylbenzene, propylene glycol monomethyl ether acetate (par.0123) but fail to disclose that such solvents may be used in combination/mixture as developer.

It is well known in the art that mixtures of organic solvents may be used as developers for photosensitive resins, as evidenced by Bantu et al. in column 1, lines 6-10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a mixture of solvents as developer for the photosensitive resin of Koyanagi et al.

In such a mixture, tetramethylbenzene is equivalent to the aromatic hydrocarbon having 9 or more carbon atoms within the molecule of the instant application.

The solvent mixture of Koyanagi in view of Bantu which is used as developer for a photosensitive composition is equivalent to the photosensitive composition remover of

the instant application. The fact that the remover is used for removal of an uncured photosensitive composition is an intended use and adds no patentable weight to the claim.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kasuya et al. (US Patent 6,002,895).

Kasuya et al. disclose solvents such as Solvesso 100, Solvesso 150, cyclohexanone, n-butyl acetate and further discloses that such solvents may be used in combination (column 18, lines 39-53).

While Kasuya et al. do not specifically disclose a solvent mixture comprising Solvesso 100 or Solvesso 150, cyclohexanone and n-butyl acetate, it would have been obvious to one of ordinary skill in the art at the time of the invention to obtain such a mixture, based on Kasuya's teaching that solvents such as Solvesso 100, Solvesso 150, cyclohexanone, n-butyl acetate may be used in combination (column 18, lines 39-53)

Solvesso 100 is known in the art as a mixture of methylethyl benzene and trimethyl benzene and Solvesso 150 is known in the art as a mixture of dimethylbenzene and tetramethylbenzene, as evidenced by Bousseau et al. (US Pg-Pub 2005/0182171) in par.0019.

Methylethylbenzene, trimethylbenzene and tetramethylbenzene are equivalent to the aromatic hydrocarbon having 9 or more carbon atoms within the molecule of the instant application.

The solvent mixture of Kasuya et al. comprises the same solvents as the photosensitive composition remover used for the removal of an uncured photosensitive composition of the instant application so it could be used as such.

### ***Response to Arguments***

8. Applicant's arguments filed on August 01, 2008 have been considered but are moot in view of the new ground(s) of rejection.

On pages 5- 9 of the Remarks the applicant is showing how the amended claims overcome the prior art rejections formulated in the previous Office Action. However, new grounds of rejection are shown above.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANCA EOFF whose telephone number is (571)272-9810. The examiner can normally be reached on Monday-Friday, 6:30 AM-4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. E./  
Examiner, Art Unit 1795

/Cynthia H Kelly/  
Supervisory Patent Examiner, Art Unit 1795